



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/484,861 | 01/18/2000 | Jeffrey Kohl Wilkins | SFT-101 | 1211 |

30869 7590 04/07/2004

LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
2345 YALE STREET, 2ND FLOOR
PALO ALTO, CA 94306

EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3623

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/484,861

Applicant(s)

WILKINS ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

MhJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,10-22,26,28 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3,5-7,10,11-22,26,28,33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Due to communications filed 1/22/04, the following is a final office action. Claims 1, 3, 5, 10-22, 26, 28 and 33 have been amended. Claims 2, 4, 8, 9, 23, 24, 25, 27, 29-32 and 34-46 have been cancelled. Claims 1, 3, 5-7, 10, 26, 28 and 33 are pending in this application and have been examined on the merits. The previous rejection has been withdrawn, and the following rejection reflects the claims as amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-7, 10-16, 19-22, 24, 26, 28, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US 6,067,525), and further in view of Cannon (US 6,286,005).

As per claim 1, Johnson et al discloses:

a) Determining appropriate purchase indicators that are leading indicators for desired near future purchases, (Col. 16, lines 21-28 and lines 52-55, [where the purchase indicator is represented by the predefined prospect formats based on product for effective selling situation]);

b) Locating, based on step a), one or more sources to search on the internet, (col. 11, lines 3-9, [installing a providing lead information at various sites]);

c) Obtaining said purchase indicators from one or more sources via an automated spider tailored to access said one or more sources, (Col. 11, lines 3-9, [where the spider is represented by the module facilitating the connection to Internet websites, and the purchase indicator is represented by the lead information]);

d) Extracting prospect identifiers from said purchase indicators in step c), wherein said prospect identifiers identify prospects, (Col. 17, lines 26-27, Col. 18, lines 37-41, [customer name through the product ordered passed to lead generation component], col. 36, lines 31-32, [converting name into a potential customer]);

e) Obtaining full contact information of each of said prospects, (Col. 18, lines 49-50, Fig. 15A, [shows types of customer information gathered; address, phone number]);

g) Obtaining data enhancement information, (Col. 16, lines 21-39, [editing to enhance flexibility]);

h) Applying a predictive model to said full contact information, said auxiliary data, and said data enhancement information to assess each of said prospects' likelihood of making said desired near future purchases, said predictive model is capable of predicting whether and what a seller is likely to buy in near future, (Col. 21, lines 30-39, [forecasting module]);

i) Selecting intenders from said prospects based on step h) said intenders having a stated or likely intention of making said desired near future purchases in

accordance with said predictive model, (Col. 21, lines 36-38, [present information based on customer], col. 36, lines 29-30, [converting a lead to a buying customer]);

Johnson et al fails to disclose extracting auxiliary data from said purchase indicators via said automated spider, but does disclose using a module that demonstrates spider abilities in Col. 11, lines 3-9.

However, Cannon discloses extracting auxiliary data from said purchase indicators in col. 12, lines 55-58 where information is retrieved from auxiliary storage. Cannon discloses this limitation in an analogous art for the purpose of showing that data in the system can be extracted from other sources such as auxiliary sources.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to extract auxiliary data from said purchase indicators with the motivation of retrieving auxiliary purchase indicator information.

Johnson et al fails to disclose behavioral data, demographic data, and psychographic data, but does disclose enhancement information in col. 16, lines 21-39.

However, Cannon discloses behavioral/psychographic data in col. 14, lines 51-52 where demographic criteria is used and in col. 14, lines 30-33, where behavior is analyzed. Cannon discloses these limitations in an analogous art for the purpose of showing that behavioral, demographic and psychographic data can all be utilized in a targeting effort.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include behavioral, demographic and psychographic data with the motivation of incorporating data that would assist with finding prospect customers.

As per claims 3, 24, Johnson et al discloses:

Further comprising the step of transferring said intenders selected in step I) to an interested party before said desired near future purchases can occur, (Col. 11, lines 54-57, represented by transferring the lead information to the salesperson);

As per claim 5, Johnson et al discloses:

Further comprising the step of initiating a direct marketing contact with said intenders selected in step i).

As per claim 6, Johnson et al discloses:

Wherein said prospect identifiers are selected from the group consisting of telephone numbers, email addresses, and postal addresses, (Col. 13, lines 7-16, represented by the addresses and phone numbers in the customer-specific information).

As per claim 7, Johnson et al discloses:

Further comprising the step of obtaining additional information associated with said prospects from a profile database, (Col. 6, lines 16-25, represented by retrieving data using one or more databases).

As per claim 10, Johnson et al fails to disclose wherein said auxiliary data are independent of said prospects, and wherein said auxiliary data are semi-structured, further comprising the step of: Translating said auxiliary data into a standard structured format, said translating step is highly tailored to said purchase indicator, but does disclose the identification of prospects in Col. 36, lines 31-32.

However, Cannon discloses wherein said auxiliary data are independent of said prospects, and wherein said auxiliary data are semi-structured, further comprising the step of: Translating said auxiliary data into a standard structured format, said translating step is highly tailored to said purchase indicator in col. 14, lines 55-58, where hard disks and floppy diskettes store data independently, w/ col. 17, lines 19-30, shows translation to binary form where the income indicator is represented by "5". Cannon discloses this feature in an analogous art for the purpose of showing how the auxiliary data is utilized.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to translate auxiliary data into a standard structured format, where the translating step is highly tailored to said purchase indicator with the motivation of translating the data into a form that can be identified with purchase indicator information.

As per claims 11, 28, Johnson et al discloses:

Wherein said one or more sources are selected from the group consisting of classified advertising, resumes, auction boards, life change announcements, and postings to newsgroups, discussion forums, and email lists /wherein said auxiliary data includes a classification of a product of said desired near future purchases, (Col. 27, lines 3-8, Fig. 15A, represented by Product Information, col. 11, lines 8-10, [where electronic advertising represents the email list], Col. 20, lines 61-64, [using email to receive/send group scheduling also represents email list]).

As per claims 12-14, neither Johnson et al nor Cannon explicitly disclose the following wherein said purchase indicators comprise classified automobile sales...classified home sales...classified boat and RV sales...

However, Johnson et al does disclose an automated sales system that incorporates electronic advertising in order to generate leads (See Col. 4, lines 21-27) and uses advertisements to do so as shown in Col. 11, lines 8-10 where electronic advertising is used. Since classified sales fits into the electronic advertisement category, the above mentioned limitations are obvious with Johnson et al.

It would have been obvious to one of ordinary skill in the art for the purchase indicators to comprise classified automobile sales, classified home sales and classified boat and RV sales because it is traditional to include classified ads in an electronic advertising environment, in order to give the customer greater flexibility in his selection process.

As per claims 15, 16, 19-21, Johnson et al does not specifically disclose wherein said purchase indicators comprise resumes...engagement/wedding announcements, birth announcements...obituaries...However, Johnson et al does disclose an automated sales system that incorporates electronic advertising in order to generate leads (See Col. 4, lines 21-27) and uses advertisements to do so as shown in Col. 11, lines 8-10 where electronic advertising is used. Since announcements are a form of advertisements, Johnson et al teaches this feature.

As per claim 22, Johnson et al discloses a digital computer system programmed to perform the method, (See abstract, lines 1-3).

As per claim 26, Johnson et al discloses:

Obtaining said data enhancement information from a profile database, wherein said data enhancement information is associated with said prospect identifiers, (Col. 27, lines 57-61, [module initiated with new information]).

As per claim 33, the following is obvious with Johnson et al since Johnson et al shows that his invention is computer implemented in coll. 35, lines 63-64 and in order for a computer to implement a program, the following is necessary:

A computer-readable medium tangibly embodying a program of instructions executable by a computer to perform the method steps of claim 1.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent 6,067,525), and further in view of Cannon (6,286,005), and further in view of Goldhaber et al (US Patent 5,855,008).

As per claim 18, both Johnson and Cannon fail to disclose wherein said auction boards comprise bids for auctioned items,

however Goldhaber et al discloses:

Wherein said auction boards comprise bids for auctioned items, and said desired near future purchases comprise purchases of items similar to said auctioned items, (Col. 4, lines 52-67, [advertisers making fixed offers]). Goldhaber et al discloses this feature in an analogous art for the purpose of showing how offers are made at auctions.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for auction boards to comprise bids for auctioned items with the motivation of informing the customer about different bidding options, thereby producing

substantial purchase indicator information.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent 6,236,977), and further in view of Cannon (US 6,286,005) and Lazarus, et al (US Patent 6,236,977).

As per claim 17, neither Johnson et al nor Cannon disclose the following wherein said postings comprise requests for purchase recommendations, but does disclose potential purchases as a customer in Col. 36, lines 31-32 of Johnson.

However, Lazarus discloses wherein said postings comprise requests for purchase recommendations , (Col. 5, lines 18-27). Lazarus discloses this limitation in an analogous art for the purpose of showing that queries can be utilized to make purchase requests.

It would have been obvious to one of ordinary skill in the art to post requests for purchase recommendations with the motivation of providing information about items being purchased thereby making it easier to determine potential leads.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3-9, 10, 11, 12-14, 17,18, 22, 23-26, 27, 29, 30-31, 32, 33-41, 42, 43, 44, 45 and 46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Art Unit: 3623

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R-B.
April 3, 2004



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 0500